

REMARKS

Claims 1-7, which are in the application, have been advanced to a condition of allowance in view of the above amendments and discussions to follow. By the above amendments Applicants have overcome the objection to the specification and the 35 USC 112, second paragraph rejection of the claims.

By the discussions below, the claims as amended overcome or avoid the rejection over Breckwoldt (US Patent No. 5,166,333) in view of Reibert et al (US Patent No. 6,235,893) as being obvious under 35 USC 103(a). Applicants discuss more fully hereunder the patentable distinction of the claims over the cited references by presenting the basis of the rejection and how they are avoided.

The rejection over Breckwoldt et al is based on the grounds that:

"The Breckwoldt patent discloses in Example 1 thereof a process for preparing methyl hydroxypropyl cellulose that comprises alkalizing 121.5 g of finely ground chemical wood pulp with 120 g 50% sodium hydroxide in an autoclave at room temperature. 152 g propylene oxide is added to the alkali cellulose. The temperature in the autoclave is slowly increased to 80°C. After cooling of the reactor 180 g sodium hydroxide and 12 mol methyl chloride per mol cellulose are introduced into the reaction vessel and the reactor is heated to 80°C for 60 minutes. After 3 hours, the methyl hydroxypropyl cellulose is freed from secondary products by washing with hot water and dried."

Based on the above, the Examiner contends that:

"The reactants disclosed in the Breckwoldt patent and the amount of the reactants disclosed in the Breckwoldt patent embraces the reactants and the equivalent amounts disclosed in the instant claims. See column 2, 8 paragraph, wherein alkalization of the cellulose may be carried out in the presence of organic solvents that may be selected as ethers containing 2 to 4 carbon atoms, which include dimethyl ether which is set forth in the instant claims as a suspension agent."

The Examiner does acknowledge the difference between the Breckwoldt et al and the claims, as follows:

"The instant claims differ from the Breckwoldt patent by reciting the presence of an alkali halide in step (a) of the claimed process during the alkalization of the cellulose."

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In an attempt to cure what is clearly a deficiency of Breckwoldt et al, the Examiner cites Reibert et al for the proposition that the presence of alkyl halide during alkalization of cellulose is known in the art. More specifically, the Examiner cites Example 1 of the Reibert et al patent as showing the presence of dimethyl ether and methyl chloride during the alkalization process.

Applicants traverse the rejection because the record is devoid of a basis for combining Breckwoldt et al with Reibert et al with a reasonable expectation of success.

At the risk of sounding rhetorical, if the suggested well know process step of employing alkali halide were suitable for Breckwoldt et al, why is this process step not employed by Breckwoldt et al.

In point of fact the record is lacking evidence or practical reason of record why Breckwoldt et al would employ the alkali halide.

It is well settled in the law that the fact that references can be combined does not render the combination obvious, unless the prior art suggests the desirability of the combination, In re Mills 16 USPQ2d 1430 (Fed. Cir 1990). In this case, the record does not show the desirability of the combination. Thus the combination is not sufficient to establish prima facie obviousness

Also, the fact that the claimed invention falls within the prior art does not necessarily render it obvious, absent some showing in the prior art which would led the skilled artisan the claimed invention, In re Vaeck 20USPQ2d 1483 (Fed. Cir. 1991).

It would therefore be helpful to Applicants for the Examiner to provide some evidence or practical reason supporting the assertion that the general knowledge of the use of alkyl halide would have led the skilled artisan to employ the same in the

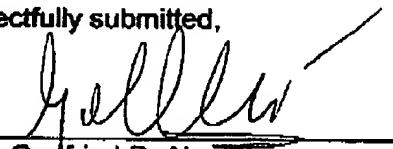
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Breckwoldt et al process. To the extent that such a showing is lacking, the Examiner would be justified in withdrawing the rejections and allowing the claims. In the alternative, Applicants hereby request an Examiner's interview to discuss the case.

Respectfully submitted,

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